UNITED STATES PATENT AND TRADEMARK OFFICE

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10/722,834	11/26/2003	Dar-Shyang Lee	15358-008700	8170

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EXAMINER
TAYLOR, NICHOLAS R

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/722,834	LEE ET AL.
	Examiner	**Art Unit**	
	Nicholas R. Taylor	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 September 2007*.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☒ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-51 have been presented for examination and are rejected.

2.   The proposed amendments to the specification filed on September 21st, 2007,

are approved.

Response to Arguments

3.   Applicant's arguments filed September 21st, 2007, have been fully considered

but they are deemed not persuasive.

4.   In the remarks, applicant argued in substance that:

(A) The prior art of Chiu does not teach generating a request to insert a portion of

a first location of a notes document. Chiu merely teaches the insertion of indexes or

links to the media streams and not the portion of information as required in the claim

language. For example, Chiu teaches the creation of digital ink strokes, thumbnails,

and background snaps that are time stamped and link into the relevant video streams

yet are not portions of the information.

As to point (A), Chiu teaches a method of taking notes in a notes document using

a wireless note-taking device (see Abstract). Chiu teaches that a user can create an

interactive, multimedia notes document of a presentation by generating requests that are based on information captured by capturing devices (see fig. 1 client application and the capture devices of figs. 2A and 2B). Chiu teaches a request generation process where a user creates a "request" that comprises, e.g., a link, screenshot, and other characteristics that are particular to the underlying captured first information (see e.g., the items of fig. 7). The generated request enables insertion (via playback) of the first captured information, which is desirable to an end user that wants to see only a portion of the original presentation.

Applicant argues that Chiu's system stores only a link, which is merely an index into the video and not a portion of the video file. The Examiner asserts that the currently amended claim language requires generating a request, determining if the request can be processed, and storing that request. The current claim language does not describe the format of the stored "request," which given a broadest reasonable interpretation of the claim language, would include a link combined with a screenshot and other information as taught in Chiu (see summary in col. 3, lines 30-57).

(B) The prior art of Chiu fails to teach "determining if the first request can be processed." Instead, Chiu merely teaches that a created insertion may be stored separately or locally with the note files (col. 6, lines 50-54) without mention of a determination process. Furthermore, the previous Office Action admits that Chiu fails to store a request. Lastly, King teaches an asynchronous message queuing system that differs entirely from Applicant's claimed invention.

As to point (B), the claim language requires "determining if the second request can be processed; and storing the second request in the notes document upon determining that the second request cannot be processed." In the language of the independent claim, no description is given as the nature of the determination process. While the claims are read in light of the specification, limitations from the specification will not be read into the claims. Given a reasonable interpretation, determining whether a request can be "processed," without more, reasonably includes determining whether a request can be created. Chiu describes this in detail, e.g., in col. 6, lines 6-54. Additionally, the combined reference King teaches determining whether a message can be "processed" (see King col. 7, lines 6-19).

As to the assertion that the previous Office Action admitted that Chiu fails to store a request in a notes document, the prior Action stated, "However, while Chiu teaches storing a request..." in page 3 of the Non-Final Office Action mailed June 22nd 2007. Chiu clearly teaches storing requests, e.g., in figure 7, which depicts multiple stored requests. As to the argument that King fails to teach storing within documents and differs from Chiu, the Examiner submits that the combined reference King teaches storing requests (i.e., messages) in a structure equivalent to the claimed notes document (see e.g., King., col 7, lines 6-19, where the asynchronous message queue 112 functions to store a series of generated one-sided request messages on a wireless device).

(C) The prior art of Chiu and King does not teach "inserting the requested portion of the captured information into the notes document." This is differentiable from merely inserting links or indexes to the stored information and is described specifically as such in Applicant's specification.

As to point (C), Chiu provides for the insertion of video into the document when the user interacts through the playback function (Chiu, col. 6, lines 35-49). While applicant's specification may further define "insertion" to specify the insertion format and other details, limitations from the specification will not be read into the claims.

(D) The prior art of Chiu fails to teach inserting a visual marker in the first location in the notes document indicative of the first request.

As to point (D), Chiu teaches requests stored in a document (see response to (A) above) that includes visual markers including, but not limited to, thumbnails, screenshots, and pen annotations (Chiu, col. 5, lines 47-67; col. 6, lines 23-35; see also the illustrative interfaces of figures 3 and 7).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Chiu et al. (U.S. Patent 6,452,615) and King et al. (U.S. Patent 6,721,288).

7.   As per claims 1, 18, 35, Chiu teaches a method of taking notes in a notes

document using a note-taking device, the method comprising:

generating a first request at the note-taking device to insert a portion of a first

information in a first location in the notes document, (Chiu, col. 6, lines 6-28; see

request processing of fig. 5 and system overview in fig. 8)

the first information comprising information captured by one or more capture

devices; (Chiu, col. 4, lines 35-60; see user device and structure of figs. 1 and 8)

determining if the first request can be processed; (Chiu, col. 6, lines 28-34 and

50-54).

However, while Chiu teaches storing a request (see Chiu, col. 6, lines 50-54),

Chiu fails to teach storing the first request in the notes document upon determining that

the first request cannot be processed.

King teaches a method for asynchronous request management based on

network availability (King, abstract and col. 6, lines 10-32) that stores requests that

cannot be processed (King, col. 6, line 56 to col. 7, line 6).

It would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to have combined Chiu and King to provide the request

management of King in the system of Chiu, because doing so would facilitate a

reduction in network delays for the note-taking device by enabling it to make

asynchronous requests and process information while the requests are stored in the

background (King, abstract).

8.   As per claims 2, 19, and 36, Chiu-King teaches the system further wherein

determining if the first request can be processed comprises determining if the note-

taking device can communicate with a server (King, col. 7, lines 6-19).

9.   As per claims 3, 20, and 37, Chiu-King teaches the system further comprising:

        determining, subsequent to storing the first request in the notes document, if the

note-taking device can communicate with a server (Chiu, col. 6, lines 6-28; see request

processing of fig. 5 and system overview in fig. 8, where a server request is processed

as normal when the server is available).

10.   As per claims 4, 21, and 38, Chiu-King teaches the system further wherein

determining if the note-taking device can communicate with the server comprises:

        detecting a first signal after storing the first request in the notes document; and

determining if the note-taking device can communicate with the server responsive to the

first signal (King, col. 11, lines 26-59 and col. 9, lines 53-61).

11.   As per claims 5, 22, and 39, Chiu-King teaches the system further wherein the

first signal is generated when the notes document is opened (King, col. 9, lines 53-61).

12.   As per claims 6, 23, and 40, Chiu-King teaches the system further wherein the

first signal is generated at a periodic interval (King, col. 11, lines 26-59).

13.   As per claims 7, 24, and 41, Chiu-King teaches the system further wherein the

first signal is generated in response to an action performed by a user of the note-taking

device (King, col. 9, lines 53-61).

14.   As per claims 8, 25, and 42, Chiu-King teaches the system further comprising:

        communicating the first request from the note-taking device to the server; (Chiu,

col. 6, lines 6-28; see request processing of fig. 5 and system overview in fig. 8)

        receiving, at the note-taking device, the first portion of the first information from

the server; and inserting the first portion of the first information in the first location in the

notes document (Chiu, col. 6, lines 28-34 and fig. 7).

15.   As per claims 9, 26, and 43, Chiu-King teaches the system further comprising:

        communicating, from the note-taking device to the server, information identifying

a user of the note-taking device requesting the first portion of the first information; (King,

col. 12, lines 38-59)

determining, at the server, if the user is authorized to receive the first portion of

the first information; and communicating the first portion of the first information from the

server to the note-taking device if it is determined that the user is authorized to receive

the first portion of the first information (King, col. 23, lines 1-7 and 34-49; see account

management of fig. 11).

16.   As per claims 10, 27, and 44, Chiu-King teaches the system further comprising:

        communicating, from the note-taking device to the server, information identifying

a user of the note-taking device requesting the first portion of the first information; and

(King, col. 12, lines 38-59)

        determining, at the server, if the user is authorized to receive the first portion of

the first information (King, col. 23, lines 1-7 and 34-49; see account management of fig.

11).

17.   As per claims 11, 28, and 45, Chiu-King teaches the system further comprising:

        determining one or more requests stored in the notes document, the one or more

requests including the first request; communicating the first request from the note-taking

device to the server; (Chiu, col. 6, lines 6-28; see request processing of fig. 5 and

system overview in fig. 8)

        receiving, at the note-taking device from the server, the first portion of the first

information; and inserting the first portion of the first information in the first location in

the notes document (Chiu, col. 6, lines 28-34 and fig. 7).

18.   As per claims 12, 29, and 46, Chiu-King teaches the system further wherein the

first information comprises information captured during a first presentation (Chiu, col. 4,

lines 47-60)

and wherein the portion of the first information is a slide displayed during the first

presentation (Chiu, col. 4, lines 47-60 and col. 5, lines 8-20; see also fig. 7).

19.   As per claims 13, 30, and 47, Chiu-King teaches the system further wherein the

first information comprises information captured during a first presentation (Chiu, col. 4,

lines 47-60)

and wherein the portion of the first information is at least one of an audio

segment recorded during the first presentation and a video segment recorded during the

first presentation (Chiu, col. 4, lines 47-60 and col. 5, lines 8-20; see also fig. 7).

20.   As per claims 14, 31, and 48, Chiu-King teaches the system further wherein the

first information comprises information captured during a first presentation (Chiu, col. 4,

lines 47-60)

and wherein the portion of the first information is at least one of an image

displayed during the first presentation, and text information recorded during the first

presentation (Chiu, col. 4, lines 47-60 and col. 5, lines 8-20; see also fig. 7).

21.   As per claims 15, 32, and 49, Chiu-King teaches the system further wherein

storing the first request in the notes document comprises: inserting a visual marker in

the first location in the notes document indicative of the first request (Chiu, see, e.g., fig.

7).

22.   As per claims 16, 33, and 50, Chiu-King teaches the system further wherein the

first information comprises information captured during a first presentation, the method

further comprising:

    generating, at the note-taking device during the first presentation, a second

request to insert a portion of a second information in a second location in the notes

document, the second information comprising information captured during a second

presentation; determining if the second request can be processed; and (Chiu, col. 6,

lines 6-28; see request processing of fig. 5 and system overview in fig. 8)

    storing the second request in the notes document upon determining that the

second request cannot be processed (King, col. 6, line 56 to col. 7, line 6).

23.   As per claims 17, 34, and 51, Chiu-King teaches the system further comprising:

    identifying one or more requests stored in the notes document, the one or more

requests including the first request and the second request; (King, col. 7, lines 6-19)

    communicating the first request and the second request from the note-taking

device to a server; (Chiu, col. 6, lines 6-28; see request processing of fig. 5 and system

overview in fig. 8)

receiving, at the note-taking device from the server, the portion of the first

information and the portion of the second information; inserting the portion of the first

information in the first location in the notes document; and inserting the portion of the

second information in the second location in the notes document (Chiu, col. 6, lines 28-

34 and fig. 7).

Conclusion

24.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-

3889. The examiner can normally be reached on Monday-Friday, 8:00am to 5:30pm,

with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number

for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the

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NT 12-3-07

Nicholas Taylor
Examiner
Art Unit 2141

JASON CARDONE
SUPERVISORY PATENT EXAMINER